

## **STATUS OF THE CLAIMS**

Claims 1-44 were originally filed in this patent application. In response to a first office action dated 01/29/2008, an amendment was filed on 04/28/2008 that cancelled claims 1-18, 22 and 24-44, amended claim 19, and added claim 45. In the pending office action, claims 19-21, 23 and 45 were rejected under 35 U.S.C. §103(a) as being unpatentable over U.S. Patent No. 7,146,496 to Circenis *et al.* (hereinafter “Circenis”). No claim was allowed. In this amendment, claims 19 and 45 have been amended, and claim 46 has been added. Claims 19-21, 23 and 45-46 are currently pending.

## **REMARKS**

### Rejection of claims 19-21, 23 and 45 under 35 U.S.C. §103(a)

The examiner rejected claims 19-21, 23 and 45 under 35 U.S.C. §103(a) as being unpatentable over Circenis.

### General Comments

In the rejections, the examiner objects to the use of “if” clauses in the claims, and states these do not narrow the claims because they can always be omitted, citing the Johnston case and MPEP §2106(II)(C). Applicant respectfully asserts the use of “if” clauses do not fall within the scope of clauses addressed by Johnston or MPEP §2106(II)(C). The Johnston case addressed use of the word “may” in a claim. Clearly the word “may” implies something may or may not happen, and therefore does not narrow a claim. The word “if” has no such optional connotation. If an “if” clause in a claim recites “if X, then Y”, one can determine whether the condition X is satisfied, and if so, can determine whether Y occurs. Thus, the scope of the claim is not rendered indefinite or optional by reciting an “if” clause. If X is not satisfied, the limitations in the claim are not optional, they simply do not apply because the condition X was not satisfied. This is especially true in claims such as claim 45 where both sides of the “if” condition are present in the claim. Thus, when a claim recites “if X, then Y” and “if not X, then Z”, the “if” clauses clearly recite limitations that narrow the claims and cannot be omitted. Applicant respectfully asserts

the examiner is misapplying the teachings of Johnston and MPEP §2106(II)(C) to “if” clauses when the use of “if” clauses clearly does not make limitations optional.

In an effort to advance the prosecution of this case, claims 19 and 45 have been amended herein to remove the “if” clauses. As a result, the examiner’s objections to the claims for containing “if” clauses is moot.

### Claim 19

Claim 19 recites:

. . . determining whether the enabled resource is shared by the selected logical partition and at least one other logical partition, and if so, metering actual usage of the at least one resource by the selected logical partition above a predetermined non-zero threshold that specifies allowable usage of the at least one resource by the selected logical partition; . . .

In rejecting these limitations in claim 19, the examiner states Circenis discloses these limitations at col. 6 lines 14-45 and col. 9 lines 15-23 of Circenis. While the cited portions of Circenis disclose tracking consumption of temporary capacity, they do not disclose many limitations in the clause of claim 19 quoted above. In particular, there is no teaching in Circenis of determining whether the enabled resource is shared. In the Response to Arguments section of the pending office action, the examiner states “shared” can be construed to mean “provided access”, and based on such interpretation, determining whether a resource is shared is analogous with determining whether a resource is accessible by the user. This statement is contrary to the common, well-known definition of the word “shared”. To alleviate the examiner’s confusion, claim 19 has been amended herein to specifically recite “determining whether the enabled resource is shared by the selected logical partition and at least one other logical partition.” This amendment makes the examiner’s interpretation of the word “shared” inconsistent with the express limitations in the claims. Nowhere does Circenis teach or suggest determining whether the enabled resource is shared by the selected logical partition and at least one other logical partition. For this reason alone, claim 19 is allowable over Circenis.

Circenis states at col. 8 lines 5-12:

Note that in the example of FIG. 2, ICOD computer system 200 has only one operating system and one set of CPUs, thereby simplifying the task of periodically adjusting the global temporary capacity balance. When the ICOD computer system is implemented as a partitionable computer system, there may be multiple ICOD software agents executing autonomously on various partitions of the partitionable ICOD computer system.

Circenis thus generally discloses the ICOD computer system may be implemented as a partitionable computer system. However, no details regarding the implementation of the ICOD computer system on a partitionable computer system are given in Circenis. Based on the mere mention of a partitionable computer system in Circenis, the examiner assumes all the detailed limitations in the claims are taught by Circenis. This is clear error by the examiner.

The examiner cites “a negative temporary capacity balance” of Circenis on the threshold in claim 19. The capacity balance of Circenis applies to the entire computer system, not to a logical partition. While Circenis mentions a partitionable computer system, this does not amount to an affirmative teaching regarding specific features of the partitions. Claim 19 recites “metering actual usage of the at least one resource by the selected logical partition above a predetermined non-zero threshold that specifies allowable usage of the at least one resource by the selected logical partition.” Note the threshold in claim 19 specifies “allowable usage of the at least one resource by the selected logical partition.” The capacity balance in Circenis applies to the entire computer system, and therefore cannot read on allowable usage of the at least one resource by the selected logical partition, as recited in claim 19. In addition, claim 19 meters actual usage of the at least one resource by the selected logical partition above the predetermined non-zero threshold. This implies the amount of capacity below the threshold is not metered. While Circenis teaches metering actual usage of a resource, Circenis is devoid of any teaching that reasonably reads on metering actual usage of the at least one resource by the selected logical partition above the predetermined non-zero threshold that specifies allowable usage of the at least one resource by the selected logical partition. For many the reasons given above, claim 19 is allowable over Circenis.

### Claims 20-21 and 23

Claims 20-21 and 23 depend on claim 19, which is allowable for the reasons given above. As a result, claims 20-21 and 23 are allowable as depending on an allowable independent claim.

### Claim 45

In rejecting claim 45, the examiner states Circenis discloses “if the selected resource is dedicated to one of the plurality of logical partitions, performing the steps . . .” and “if the selected resource is not dedicated to one of the plurality of logical partitions and is shared between first and second logical partitions.” Circenis does states in col. 8 quoted above the ICOD computer system may be implemented as a partitionable computer system. However, this statement does not amount to an affirmative teaching that distinguishes between a resource that is dedicated to a logical partition and a resource that is shared between logical partitions. Nowhere does Circenis make any distinction between a resource dedicated to a logical partition and a resource shared by multiple logical partitions. For this reason alone, claim 45 is allowable over Circenis.

In rejecting claim 45, the examiner states Circenis discloses “performing the above-mentioned steps for each logical partition (i.e., using a selected resource without charge until metered use exceeds a first predetermined non-zero threshold, metering use of the selected resource, and sending a record of metered usage).” Note, however, the limitation of using a selected resource without charge until metered usage exceeds a first predetermined non-zero threshold is not present in claim 19, and therefore was not addressed by the examiner’s rejection of claim 19. Because the examiner has cited no portion of Circenis as allegedly teaching this limitation, the examiner has failed to establish a *prima facie* case of obviousness for claim 45 under 35 U.S.C. §103(a). Nowhere does Circenis teach or suggest enabling the selected resource for use, then using the selected resource *without charge* until the metered usage exceeds a first predetermined non-zero threshold. In Circenis, all the usage is metered and charged. Claim 45 thus patentably distinguishes over Circenis by using a selected resource without charge until metered usage exceeds a first predetermined non-zero threshold, then metering only the use of

the selected resource by the first logical partition that exceeds the first predetermined non-zero threshold.

Claim 45 expressly recites a first predetermined non-zero threshold that specifies allowable usage of the selected resource by the first logical partition, and a second predetermined non-zero threshold that specifies allowable usage of the selected resource by the second logical partition. The examiner has not shown any teaching in Circenis that allegedly reads on these two limitations, and has therefore failed to establish a *prima facie* case of obviousness for claim 45 under 35 U.S.C. §103(a). The examiner appears to assume the capacity balance in Circenis somehow reads on both of these limitations. However, the teaching in Circenis of a single capacity balance for the entire computer system and the fact the computer system may be partitionable does not amount to an affirmative teaching of separate thresholds for usage for each logical partition, especially when usage below the thresholds is not charged, and only usage that exceeds these thresholds is metered and billed.

In rejecting the clause “sending a record of metered usage to the resource provider based on value of the meter timer”, the examiner cites co. 6 lines 46-60 of Circenis, which discloses the ICOD software agent may inform the user the current rate of consumption. The user in Circenis does not read on “the resource provider” in claim 45. According to the examiner’s mapping of Circenis on the limitations in claim 45, the resource provider in Circenis is the entity that provided the code word. Nowhere does Circenis teach or suggest sending a record of metered usage of the selected resource that exceeds the first predetermined non-zero threshold *to the resource provider* as recited in claim 45. In addition, claim 45 recites:

. . . sending a record of metered usage of the selected resource by the first logical partition that exceeds the first predetermined non-zero threshold to the resource provider;

. . . sending a record of metered usage of the selected resource by the second logical partition that exceeds the second predetermined non-zero threshold to the resource provider; . . .

The result is claim 45 sends a record of metered usage to the resource provider based on value of the meter timer when the selected resource is dedicated to one of the plurality of logical partitions, and when the selected resource is not dedicated to one of the plurality of logical

partitions and is shared between first and second logical partitions, sends a record of metered usage for both first and second logical partitions that exceeds respective first and second predetermined non-zero thresholds. Nowhere does Circenis teach the sending of these three different records of metered usage to the resource provider under the specific conditions specified in claim 45.

For the many reasons given above, claim 45 is allowable over Circenis. Applicant respectfully requests reconsideration of the examiner's rejection of claim 45 under 35 U.S.C. §103(a).

#### Claim 46

Claim 46 has been added herein, and includes many of the limitations disclosed in applicant's FIG. 7. Claim 46 includes many of the limitations in claim 45 discussed above, and is therefore allowable for the same reasons.

Conclusion

In summary, none of the cited prior art, either alone or in combination, teach, support, or suggest the unique combination of features in applicant's claims presently on file. Therefore, applicant respectfully asserts that all of applicant's claims are allowable. Such allowance at an early date is respectfully requested. The Examiner is invited to telephone the undersigned if this would in any way advance the prosecution of this case.

Respectfully submitted,

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